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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,293	08/29/2000	Chijioke Chukwuemeka	24065.50	9866

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EXAMINER
HAQ, NAEEM U

ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/650,293	Applicant(s) CHUKWUEMEKA, CHIJIOKE
	Examiner Naeem Haq	Art Unit 3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 May 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-27* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Response to Amendment

This action is in response to the Applicant's amendment A, paper number 4, filed on May 28, 2003. Claims 1-27 are pending, and will be considered for examination.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11, 18, and 19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 20, and 22 of copending Application No. 10/270,981. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences are merely obvious variations. Both sets of claims are directed to online transactions using a token as a method of payment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ling (US 2002/0002538 A1) in view of Official Notice and further in view of Applicant's admission of prior art.

Referring to claims 1, 7-9, 11, 14-19, Ling teaches a method of performing at least one transaction between a consumer from a plurality of consumers and a merchant from a plurality of merchants, the plurality of consumers and the plurality of merchants utilizing computing devices connected to a network, said method comprising the following steps of: providing a token to at least one clearing server (page 2, paragraphs [0022]–[0037]; page 11, paragraph [0153]–page 12, paragraph [0160]); determining an amount paid by the consumer to a previous merchant (page 5, paragraph [0075]); combining into a total price, prices of all selected for purchase at least one quote (page 4, paragraph [0063]; page 8, paragraph [0114]). Ling does not explicitly teach communicating a request for an update key to the clearing server, or providing the update key as an authorization to modify the value of the token. However, Ling teaches that a vendor can issue the tokens directly to a consumer (page 4, paragraph [0065]), and that such communication may be encrypted (page 4, paragraph

[0067]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate encryption into the method of Ling. One of ordinary skill in the art would have been motivated to do so in order to ensure that the token was properly protected. Furthermore, since the vendor issues the tokens directly to the consumer, the vendor must inherently have some way (i.e. a key) to decrypt and modify the value of the token. Finally, Ling does not teach rejecting the transaction if the value of the token is less than the total price. However, Official Notice is taken that it is old and well known in the art to reject a transaction if the method of payment is insufficient to cover the cost the transaction. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to reject a transaction in the method of Ling if the token amount was less than the total price. One of ordinary skill in the art would have been motivated to do so in order to ensure that the vendor was properly compensated for the transaction.

Referring to claims 2, 12, 13, and 21-27, Ling teaches that the consumer purchases the tokens from an online vendor (page 4, paragraphs [0063]–page 5, paragraph [0074]). Although the Ling does not explicitly teach that the consumer purchases the tokens from a clearing server, the Examiner notes that the claim language does not explicitly differentiate the merchant and the clearing server as separate and distinct entities. Furthermore, the Examiner notes the vendors in Ling's method must inherently have some sort of server connected to a network since the vendors conduct business over the Internet. Ling does not teach maintaining the token in only random access memory of a computer device. However, Official Notice is taken

that it is old and well known in the art to use RAM as a temporary storage for data. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to store the token of Ling in only RAM. One of ordinary skill in the art would have been motivated to do so in order to temporarily store the token in an easily accessible location on a computer.

Referring to claims 3-5, Ling teaches that the consumer provides personal and financial information regarding a payment instrument to be used by the consumer (page 6, paragraph [0095]).

Referring to claim 6, Ling teaches that the user may be issued tokens at the time of registration as an incentive (page 6, paragraph [0092]). Ling further teaches the user may purchase additional tokens at a later date (page 7, paragraph [0102]). Therefore the originally issued tokens at the time of registration would inherently be considered 'previously purchased' since they were issued prior to the later purchased tokens.

Referring to claims 10 and 27, Ling does not teach that the step of determining said amount paid is performed by polling previous merchants to receive at least two information uploads from the merchant to said clearing server. However, the Applicant admits that polling of previous merchants for information uploads is old and well known (see specification page 2, lines 24-27). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method Ling. One of ordinary skill in the art would have been motivated to do so in order to obtain an approximation of the consumer's spending.

Response to Arguments

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (703)-308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-1113

Naeem Haq, Patent Examiner
Art Unit 3625

September 8, 2003

WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600